

Remarks

The present Amendment is made in response to the Office Action dated June 1, 2006, and identified as Paper No. 20060526. Claims 1-17 are pending.

In the Action, the Examiner rejected claim 1 under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,152,815 to Zievers ("*Zievers*"). Claims 7 and 16 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 4,488,965 to Muller ("*Muller*"). Claims 2-3 and 5-6 were rejected under 35 U.S.C. § 103(a) as obvious over *Zievers* in view of *Muller*. Claim 4 was rejected under 35 U.S.C. § 103(a) as obvious over *Zievers* and *Muller* in view of U.S. Patent No. 3,438,502 to Schmidt ("*Schmidt*"). Claims 8 and 17 were rejected under 35 U.S.C. § 103(a) as obvious over *Muller* in view of U.S. Patent No. 5,833,725 to Dehn ("*Dehn*"). Claim 9 was rejected under 35 U.S.C. § 103(a) as obvious over *Muller* and *Dehn* in further view of U.S. Patent No. 2,278,148 to Monsarrat ("*Monsarrat*"). Claims 10-14 were rejected under 35 U.S.C. § 103(a) as obvious over *Muller* in view of *Schmidt*. Claim 15 was rejected under 35 U.S.C. § 103(a) as obvious over *Muller* and *Schmidt* in further view of U.S. Patent No. 1,873,594 to Johnson ("*Johnson*").

I. *Zievers* does not disclose each and every limitation of claim 1 as required for a rejection under 35 U.S.C. § 102

A rejection under 35 U.S.C. § 102 requires that the reference include each and every limitation recited in the claims. MPEP § 2131 ("A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference"). The invention recited in claim 1 calls for a "rack that is slidingly engaged with said compartment and adapted for movement in a substantially horizontal plane into and out

of said compartment.” This express claim element and associated limitation is utterly absent from the cited reference.

In particular, *Zievers* discloses a filtration tank having several tiers of racks 30 that are suspended in the tank and hermetically sealed to the inside of the tank. Col. 2, lines 14-26. *Zievers* fails to disclose any structure that would allow rack 30 to be slid into and out of the tank as affirmatively called for in claim 1. Maintenance of the tank of *Zievers* actually requires the removal of a cover plate 60 positioned on the side of the tank (see Fig. 1), thereby allowing “the removal, inspection and replacement of *individual filter tubes . . .*” Col. 2, lines 60-61 (emphasis added). Rack 30 is therefore not “slidingly engaged with said compartment and adapted for movement in a substantially horizontal plane into and out of said compartment” as required by claim 1. In fact, the structure of *Zievers* (a cylindrical tank composed of sections 15, 16, and 17 stacked on top of each other) make it impossible for any of the racks inside to be slid into and out of the compartments as recited in the claims

Notably, *Zievers* is representative of the type of conventional tanks (see Paragraph [0003] of Applicant’s Specification) that must be taken off line and/or disassembled for servicing. The slidingly engaged racks of the claimed invention provide a distinct advantage over *Zievers* in that the rack can be slid out of the filter cabinet for easy maintenance of the filter candles, while keeping filtration on-line throughout the rest of the filter vessel. See Paragraph [0032]. As the racks of *Zievers* are not slidingly engaged with the compartments of the vessel, the reference lacks an express limitation of the claimed invention and therefore does not anticipate claim 1.

II. *Muller* does not disclose each and every limitation of claims 7 and 16 as required for a rejection under 35 U.S.C. § 102

According to the Examiner, *Muller* discloses a tubular rack 7 having a male connector that is removably positioned in a compartment of a filtration vessel. A closer examination of *Muller* reveals that although the structure identified by the Examiner may be interpreted to be a rack (the structure is actually collecting pipe 7), the collecting pipe 7 is not removably positioned in a compartment of the vessel as required by claim 7. In addition, several other express claim limitations are missing from *Muller*.

With regard to the removably positioned of the rack, the portion of the specification identified by the Examiner as explaining removable positioning does not disclose removably positioning, nor does it apply to collecting pipe 7. At that section of the specification, *Muller* described the structures used to attach filter candles to the pipe. Col. 3, lines 11-16. More importantly, the specification states that "the attachment of the outlet piece 12 is provided in the same manner as the attachment of the support body 11 to the T-shaped pipe piece 10'," which is by *welding*. Col. 3, lines 1-6. Accordingly, even if the structure identified by the Examiner was analogous to the claimed rack, it cannot conceivably be *removably* positioned within the vessel as it is *welded in place*.

The Examiner also failed to identify how *Muller* discloses the claimed female connector in the compartment that interconnects to the male connector of the rack as the rack is removably positioned in the compartment. The structures identified by the Examiner do not have male and female connectors, nor are the male and female connectors brought into and out of engagement with each other when the rack is removably positioned in the compartment. As described above, all of the parts identified by the Examiner are *welded* together, thereby precluding removable positioning as affirmatively recited in the claims.

III. The various combinations of references proposed by the Examiner fail to disclose each and every limitation of claims 2-6 and lack a sufficient motivation as required for a rejection under 35 U.S.C. § 103

As explained above, *Zievers* fails to disclose a “rack that is slidably engaged with said compartment and adapted for movement into and out of said compartment.” Accordingly, the various combinations of prior art proposed by the Examiner for the purposes of the section 103 rejection necessarily fail to disclose each and every limitation of the claims. As a result, the Examiner has not presented a *prima facie* case of obviousness and the rejections should be withdrawn. MPEP § 2143.03 (“To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art”).

With respect to claim 3, the structure identified by the Examiner as comprising the claimed mounting plate and chamber above the mounting plate is actually an elongate gasket 48 having a circular hole 49 formed therethrough. There is no chamber above the gasket 48, as required by claim 3. With regard to the remaining combinations, the Examiner failed to provide a sufficient motivation or suggestion to make the combination proposed by the Examiner. MPEP 2143.01 (“Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art”).

In some circumstances, the Examiner identified that the references proposed in the combination were both directed to the same invention. A proper motivation or suggestion, however, requires identification of a *reason* why one of ordinary skill in the art would combine the reference, and not simply an identification that the references are combinable. MPEP § 2143.01(III) (“The mere fact that references can be combined or modified does not render the

resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)").

IV. The various combinations of references proposed by the Examiner fail to disclose each and every limitation of claims 8-15 and 17 and lack a sufficient motivation as required for a rejection under 35 U.S.C. § 103

As explained above, *Muller* lacks one or more express limitations of claim 7. As a result, the various combinations proposed by the Examiner to support the rejections under 35 U.S.C. § 103 also lack one or more express limitations of claim 7 and therefore fail to state a *prima facie* case of obviousness.

In view of the foregoing amendments as supported by these remarks and accompanying documents, the Examiner's reconsideration and allowance of the present application is respectfully requested. If the Examiner believes that a telephone conference will expedite handling of the present application, please contact the undersigned at (315)218-8515.

Respectfully submitted,

Dated: September 1, 2006

By: 

George R. McGuire
Reg. No. 36,603

BOND, SCHOENECK & KING, PLLC
One Lincoln Center
Syracuse, New York 13202-8530
(315)218-8515